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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,016	01/12/2001	Russell E. Parks	FIS9-2000-0282	1797
30743	7590	05/31/2005	EXAMINER	
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			OUELLETTE, JONATHAN P	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/759,016	PARKS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 February 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

***DETAILED ACTION***

***Claim Rejections - 35 USC § 101 and 35 USC § 112***

1. The rejection of Claims 1-7 under 35 U.S.C. 101 is withdrawn due to the Board of Appeals decision.
2. The rejection of Claims 1-7 under Claims 1-7 under 35 U.S.C. 112 is withdrawn due to the Board of Appeals decision.

***Claim Rejections - 35 USC § 102***

3. The rejection of Claims 1-7 under 35 U.S.C. 102(e) as being anticipated by Puram et al. (US 6,289,340 B1) is withdrawn due to the Board of Appeals decision.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puram et al. (US 6,289,340 B1).
6. As per **independent Claims 1, 4, and 5**, Puram discloses a (Web-based, computer system) Skills Matching Application (SMA) which allows a user to communicate

requirements to technical service suppliers in a way that significantly reduces the process time and improves the accuracy of requests sent to suppliers comprising the steps of: means for accessing the SMA from a Requisition/Catalog (REQ/CAT) application; means for prompting a user through a series of screens to enter a Statement of Work (SOW) and complete a skills detail checklist for each of the technical skills requested (Fig.2-185, C2 L44-50, C5 L60-65); means for receiving from a supplier a candidate or candidates with appended resumes as appropriate; and means for displaying for the user the supplier responses and associated resumes (C8 L30-34).

7. Puram fails to expressly disclose means for submitting the request to contracted suppliers by e-mail notification notifying the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against.
8. However, Puram does disclose using an Internet accessible interface to automatically review employer needs and match possible candidates (Fig.2-3, C3 L28-47), and it would have been obvious to one of ordinary skill in the art at the time the invention was made for the user to submit a request for a skilled candidate directly to a supplier via-email (e-mail was a well known technology at the time the invention was made), rather than matching candidates having certain desired skills with a database of employer needs via the internet, as the invention disclosed by the prior art of Puram would be an advancement to the invention disclosed by the applicant - incorporating automated Internet processing into the element steps of requesting and receiving matching candidates, as disclosed by the applicant.

9. As per Claims 2 and 6, Puram discloses wherein the SMA and REQ/CAT applications are Web-based and an SMA Web site is provided for suppliers to access to view request details and submit a candidate or candidates (Abstract, Figs.1b and 1c).
10. As per Claims 3 and 7, Puram discloses responding to a user's selection of a candidate or candidates by invoking an approval and procurement process (C7 L65-67, C9 L3-10).

***Response to Arguments***

11. Therefore, applicant's arguments filed 2/14/2005 have been fully considered but are no persuasive. The rejection will remain as final based on the sited prior art.
12. The applicant has made several arguments suggesting that the prior art of Puram fails to disclose the elements discloses in Claims 1-7.
13. However, the examiner disagrees and points the applicant to the specific sited portions of Puram after/within each rejection of claims 1-7 above.
14. Furthermore as stated in the rejection of claims 1, 4, and 5 regarding the failure of Puram to disclose means for submitting the request to contracted suppliers by e-mail notification notifying the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against.
15. Puram does disclose using an Internet accessible interface to automatically review employer needs and match possible candidates (Fig.2-3, C3 L28-47), and it would have been obvious to one of ordinary skill in the art at the time the invention was

made for the user to submit a request for a skilled candidate directly to a supplier via-email (e-mail was a well known technology at the time the invention was made), rather than matching candidates having certain desired skills with a database of employer needs via the internet, as the invention disclosed by the prior art of Puram would be an advancement to the invention disclosed by the applicant - incorporating automated Internet processing into the element steps of requesting and receiving matching candidates, as disclosed by the applicant.

16. Finally, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the certain features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

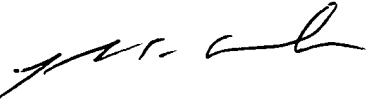
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers

Art Unit: 3629

for the organization where this application or proceeding is assigned (703) 872-9306  
for all official communications.

19. Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the receptionist whose telephone number is (703)  
306-5484.

May 25, 2005

  
**JOHN G. WEISS**  
SUPERVISOR EXAMINER  
TE 3600